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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,578	11/07/2001	Prem Chandar	J6674(C)	4054

201 7590 10/20/2004

UNILEVER
PATENT DEPARTMENT
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EXAMINER	
YU, GINA C	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/036,578	CHANDAR ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,7,8 and 13-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,7,8 and 13-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on July 21, 2004. Claims 1, 2, 7, 8, 13-16 are pending. Claim rejections made under 35 U.S.C. § 103(a) as indicated in the previous Office action dated May 6, 2004 are withdrawn and modified to address the new limitation and claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 7-8, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granger et al. (USPN 5,716,627) in view of Potter et al. (USPN 5620692).

Granger et al. (USPN 5,716,627) teaches a skin-conditioning composition comprising (a) from about 0.001% to about 10% of retinol or retinyl ester, (b) from about 0.0001% to about 50% azole (e.g., climbazole), (c) about 0.0001% to about 50% of LMEA and (d) a cosmetically acceptable vehicle, see claim 1 and col. 2, lines 31-62, see also examples 8 and 10. See instant claims 1, 2, 7, 8. Granger also teaches the employment of azoles in an oil-in-water emulsion, see example 7 in col. 16. Granger further teaches the employment of from about 0.5% to 50% emollients such as esters, fatty acids, alcohols, polyols and hydrocarbons, see col. 5, lines 20-26. Granger finally teaches the employment of imidazole compounds in its composition, see for example col. 6, lines 6-12.

While the reference does not expressly teach that each ingredient in the oil phase should have the peroxide value as recited in the instant claims, the limitation is considered met because the prior art composition comprises the same constituent of the oil phase of the emulsion.

Potter et al. teach, "[t]he peroxide value of a lipid provides an indication of the amount of rancidity-inducing peroxide radicals present in the lipid and is inversely correlated with product stability". See col. 1, lines 34 – 37. The reference further teaches that the peroxide value indicates the oxidative stability of the fat and its antioxidant effectiveness. See col. 1, lines 37-41. The reference also teaches that freshly prepared oil or highly preferred oil of the prior art has a peroxide value of zero. See col. 1, lines 41 – 45; col. 4, lines 7 – 14.

Examiner views that the new limitation, "to ensure the retinoid half life of at least about 20 days at 50 C" recites the motivation of applicants to use the oil. It is noted that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. See In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). The court there further held that granting a patent on the discovery of an unknown but inherent function "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." See 596 F.2d at 1022, 201 USPQ at 661. The court in Ex parte Obiaya also held, "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." See 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) In

this case, the fact that the oil phase of the instant invention renders "the retinoid half life of at least about 20 days at 50 C" is viewed the discovery of an unknown but inherent function of the oil of having low peroxide value which is in the public domain by virtue of its obviousness from the prior art because the stable character of these oils are already known in the public. The skilled artisan would have been motivated to use the oils in expectation of producing a stable composition. The stability function of the oils as recited by applicants is viewed as an advantage which is newly recognized by applicants but "flow naturally" from following the suggestion of the reference. The stability properties of the oils cannot be the basis of patentability because the reference indicates the stabilizing effects of the claimed oils.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Granger by using oils having low peroxide values as motivated by Potter et al. because of the expectation of successfully producing stable cosmetic composition with effective antioxidant properties.

Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granger et al. (USPN 5,716,627) and Potter et al. (USPN 5,620,692) as applied to claims 1-2 and 7-8, 13 and 15 above, and further in view of Granger et al. (WO 98/13020).

Granger et al. (USPN 5,716,627) teaches that mono and diethanolamides of palmitic acid is among the preferred fatty acid amides. See col. 3, lines 65 – 67. The combined references do not teach the employment of alpha-ionone in its composition.

Granger et al (WO 98/13020) teaches a skin conditioning composition for topical application comprising from 0.001% to 10% of retinol or retinyl ester, from 0.0001% to 50% of a compound which inhibits LRAT or ARAT catalyzed retinol esterification such as, alpha ionone, and a cosmetically acceptable carrier, see page 10, lines 17-18; page 3; page 35 table 7 for example. Granger also teaches optional ingredients such as linoleic acid, mono or di esters, fatty alcohols, polyols and hydrocarbon. See for example page 15-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ alpha-ionone in the skin care composition of the combined references as motivated by Granger (WO 09/13020) because alpha-ionone is known to be useful (together with retinoids and the excipients herein) in skin care conditioning compositions.

Oath/Declaration

Declaration filed on July 21, 2004 has been fully considered but does not place the application in allowable condition. The declarant there states as an expert that the stabilizing effect of the oils having POV of less than 12 provides an improved half-life of retinoid "is unexpected".

The statement is an opinion statement. Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so

long as the opinion is not on the ultimate legal conclusion at issue. See MPEP § 716.01(c)(III). While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. See In re Chilowsky, 306 F.2d 908, 134 USPQ 515 (CCPA 1962); In re Lindell, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. See Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). In this case, the declarant's statement that the claimed invention is nonobvious is offered to show the ultimate legal conclusion at issue. Since the statement is based on the evidence on specification, examiner considered the evidence and the opinion statement. The teachings and suggestions of the prior arts were also considered to determine the probative value of the expert opinion. It is noted that the opinion was made only in view of the Granger reference alone, and without the Potter reference which teaches that oils having low POV are expected to provide higher stability in a composition. In this case, examiner concludes that the expert opinion does not overcome the prima facie obviousness of the present case because the opinion was made without the teachings of Potter, which was available to one of ordinary skill in the art at the time of the invention.

Response to Arguments

Applicant's arguments filed February 19, 2004 have been fully considered but they are not persuasive.

Applicants argue that Granger '627 fails to disclose the same ingredients as claimed in the invention. Examiner respectfully reminds applicants that the present rejection is made under the obviousness standard. The formulation that are disclosed in the reference may not be the exactly same as the claimed invention. However, in view of the Potter reference which teaches the advantage of oils having low POV's, the skilled artisan would have found it obvious to use the low POV oils to make the Granger invention.

Examiner respectfully disagrees with applicants' contention that Potter fails to teach or suggest specific materials and/or specific POV values as claimed. The claimed invention does not define any specific oils. The claims only limit the POV's of the oil components in the emulsion to be less than 12. The Potter reference does teach that the oil having zero POV, which meets that limitation, is highly preferred.

Applicants argue that Granger '020 "teaches away from using a fatty acid amide" merely because, in the description of the invention, the reference describes that its retinoid booster compounds are not fatty acid amides. Examiner takes the position that the teaching in p. 3 and claim 1 of the '020 patent merely sets forth the metes and bounds of the patent limitation, and does not in any way provide any teaching or suggestion that the retinoid boosters of the '020 reference should not be combined with fatty acid amides.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner.

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER